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SHAH, AMEE A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,133

Applicant(s)

AARON ET AL.

Examiner

AMEE A. SHAH

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-24 are pending in this action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2008, has been entered.

Specification

The use of the trademarks MICROSOFT OUTLOOK and ACTIVEX has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. §101 because the method is not tied to a machine not does it transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a §101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 1-9 are non-statutory since they may be performed within the human mind or by hand. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC §101. Note the Board of Patent Appeals Informative Opinion *Ex parte Langemyer et al*- available at http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(c), (f) or (g) prior art under 35 U.S.C. §103(a).

Claims 1-4, 6, 8, 9-13, 15, 17-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al., US 2002/0046093 A1 (hereafter referred to as “Miller”) in view of Lucas, US 2001/0051905 A1 (hereafter referred to as “Lucas”).

Referring to claim 1, Miller teaches a method for automating recurrent electronic transactions conducted over a network, comprising:

- performing analysis of electronic activities conducted by a network user (¶¶0131 and 0191); and
- inferring an intent to execute a transaction by said network user without any explicit action by the user to execute the transaction (¶¶00126-00131 - note that the system analyzes the user history to give product information and promotions based on an inferred intent to purchase a particular product in the future without the user explicitly requesting information on that particular product); and
- wherein the analysis includes:
 - comparing the electronic activities with previously-conducted electronic activities by the network user (¶¶0132-0134 and 0192); and
 - applying user-defined policies to the electronic activities (¶¶0159 and 0163 – note the user-defined policies are the requirements for product attributes and vendors).

While Miller teaches inferring an intent to execute a transaction, it does not specifically teach automatically executing the transaction on behalf of the user including executing a purchase of a service/product on behalf of the network user. Lucas teaches a system and method

for monitoring inventory wherein the server electronically tracks and evaluates usage habits and automatically executes on behalf of the customer, i.e. network user, a purchase transaction for items needed (§§0026, 0082 and 0085-0087).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Miller the ability to automatically execute on behalf of the user the purchase transaction inferred from the user, as taught by Lucas, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one ordinary skill in the art would have recognized that results of the combination were predictable.

Referring to claim 2. Miller in view of Lucas further teaches the method of claim 1 wherein said electronic activities include at least one of accessing a web site, performing a detectable user action on a web page, drafting an email, searching a web-based electronic search engine, accessing a personal information calendar, entering a new task or accessing an existing task in an electronic task folder, and creating, editing, or viewing a document (Miller, §§0131 and 0191 – note the electronic activities can be accessing a website, performing a detectable user action, or searching a search engine).

Referring to claim 3. Miller in view of Lucas further teaches the method of claim 1 wherein said comparing said electronic activities with previously-conducted electronic activities further comprises:

- collecting data entered by said network user (Miller, ¶¶0130 and Lucas, ¶¶0082 and 0085);
- parsing said data by comparing said data to data stored in a database containing said previously-conducted electronic activities, said parsing resulting in a suggested electronic transaction for execution (Miller, ¶¶0131, 0132, 0191 and 0192 – note the suggested electronic transactions are the related products available for purchase, and Lucas, ¶¶0082 and 0085);
- searching said database for related resources associated with said suggested electronic transaction (Miller, ¶¶0131 and 0132 – note the related resources are the related products, and Lucas, ¶¶0082 and 0085); and
- searching a profile database storing policies and rules created by said network user, said policies and rules operable for specifying conditions for authorizing and executing said suggested electronic transaction (Miller, ¶¶0141 and 0161-0164);
- wherein said policies and rules include at least one of placing an upper limit on an amount of money that is authorized to be spent on a transaction, placing a time limit on when a transaction may be executed, prescribing authorized vendors, suppliers, or entities through which a transaction may be entered, and specifying delivery options for items and services associated with a transaction (Miller, ¶¶0141 and 0161-0164 – note the policies and rules are prescribing certain vendors based on geographic location and specifying delivery options such as availability of delivery).

Referring to claim 4, Miller in view of Lucas further teaches the method of claim 3 further comprising searching a service/product database to ensure said items and services associated with said transaction are available (Miller, ¶¶0155 and 0164).

Referring to claims 6 and 8, Miller in view of Lucas further teaches the method of claim 1 comprising generating an electronic invoice upon execution of said transaction (Miller, ¶0184 – note the shopping cart is the electronic invoice), and notifying said network user that said transaction has been completed (Miller, ¶0235 - note the notification is performed by email).

Referring to claim 9, Miller in view of Lucas further teaches the method of claim 1 wherein said previously-conducted electronic activities include at least one of an occurrence of a meeting including parameters comprising, a number of participants, a meeting location, a time of day, and meeting resources and materials, a web site search, an electronic purchase, an email message received or transmitted by said network user, a calendar item generated or accessed by said network user, and a task item generated or accessed by said network user (Miller, ¶¶0131 and 0191 – note the electronic activities include web site searches and electronic purchases).

Referring to claims 10-13, 15, 17-22 and 24, All of the limitations in apparatus claims 1-13, 15, 17-22 and 24 are closely parallel to the limitations of method claims 1-4, 6, 8 and 9, analyzed above, and are rejected on the same bases.

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Lucas and further in view of Agrawal et al., 6,061,682 (hereafter referred to as “Agrawal”).

Referring to claim 5. Miller in view of Lucas teaches the method of claim 3 but does not specifically teach searching a service/product database to ensure that said items and services associated with said transaction are compatible with said transaction. Agrawal, in the same field of endeavor and/or related to the same issue, teaches a method of creating associations between products including searching databases to ensure that items and services are compatible with the transaction, i.e. product (see, e.g., col. 3, lines 25-37).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of searching a database to ensure products are compatible, as taught by Agrawal, with the known elements of analyzing user data, parsing data and searching for suggested related products, as taught by Miller and Lucas, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Agrawal and Miller would yield the predictable results of producing economic value to advertisers by providing associations that are more likely to lead to sales, as suggested by Agrawal (col. 3, lines 25-37).

Referring to claim 14. All of the limitations in apparatus claim 14 are closely parallel to the limitations of method claim 5, analyzed above, and are rejected on the same bases.

Claims 7, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Lucas and further in view of Official Notice, as admitted by applicant to be prior art.

Referring to claim 7. Miller in view of Lucas teaches the method of claim 6 wherein said notification is sent via email and wherein graphical user interfaces can be used instead (Miller, ¶0279). While Miller does not explicitly teach that notification can be done using an application programming interface, it was old and well known at the time of the invention to use application programming interfaces with graphical user interfaces to send notifications. One of ordinary skill in the art would have done so for the predictable result of having a more user-friendly notice. Since applicant did not traverse the official notice in previous office actions, applicant has admitted that use of a GUI is prior art.

Referring to claims 16 and 23. All of the limitations in apparatus claims 16 and 23 are closely parallel to the limitations of method claim 7, analyzed above, and are rejected on the same bases.

Response to Amendment

Applicant's amendment, filed October 10, 2008, has been entered. Claims 1, 10 and 19 have been amended.

Response to Arguments

Applicant's arguments with respect to claim 1- 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: (1) Walch et al., US 2002/0152128 A1, discloses a system and method for delivering remotely ordered consumer items wherein a record is maintained of the customer's previous orders and which is used to automatically re-order items on a subscription bases, i.e. automatically executing a purchase transaction on behalf of the network user (see, e.g., pages 2-7, particularly ¶¶0052-0063); and (2) Kerker et al., US 7,353,194 B1, discloses a system and method for managing recurring orders in a computer network wherein a recurrent order management system automatically executes a purchase transaction to order products that are suggested and/or set to be recurring orders (see, e.g., Abstract and columns 4-10 and 33-44).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amee A Shah/
Examiner, Art Unit 3625

AAS

January 6, 2009